

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. LEWIS, HIEN Q. NGUYEN,
DARYL G. BAXA, DAVID STONE,
and PARISA SALIMI

Appeal 2006-2621
Application 09/993,320
Technology Center 2100

Decided: March 27, 2007

Before JOSEPH F. RUGGIERO, ALLEN R. MACDONALD, and
JEAN R. HOMERE, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-40 and 69-81. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method and apparatus which permits a communications device to use the device ID and programs stored on a boot PROM to connect to a management device. The appropriate operating software and/or firmware for the particular communication device model are selectively downloaded to the communication device from the management device.

Claim 27 is illustrative of the claimed invention, and it reads as follows:

27. A method of operating a communications system, comprising:
- initializing one or more communication devices from routines stored on a boot PROM of each of the one or more communication devices;
 - receiving a device ID from each of one or more communication devices at a management device;
 - initiating a firmware upgrade without an administrator based on the device ID of each of the one or more communication devices;
 - selecting a software program associated with the device ID of each of the one or more communication devices that requires a firmware upgrade; and
 - downloading the software program associated with the device ID to each of the one or more communication devices that require a firmware upgrade.

The prior art relied upon by the Examiner in rejecting the claims on appeal are:¹

Treu	5,245,615	Sep. 14, 1993
Ha	US 6,175,919 B1	Jan. 16, 2001
Ishibashi	US 6,654,820 B1	Nov. 25, 2003 (filed Mar. 31, 2000)
Itoh	US 6,795,912 B1	Sep. 21, 2004 (filed Sep. 27, 2000)

Douglas E. Comer (Comer), *Computer Networks And Internets*, Second Edition, Prentice Hall, 156-58, 515 (1999).

The Examiner rejected claims 27-29, 32, 75-77, 79, and 80 under 35 U.S.C. § 102(e) based upon the teachings of Ha. The Examiner further rejected claims 1-26, 30, 31, 33-40, 69-74, 78, and 81 under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Ha alone with respect to claims 33 and 78, adds Itoh to Ha with respect to claims 1-5, 7, 10, 12, 13, 15-19, 30, 69-73, and 81, adds Ishibashi to Ha and Itoh with respect to claims 6, 8, 9, 11, and 74, adds Treu to Ha and Itoh with respect to claim 14, and adds Ishibashi to Ha with respect to claim 31. Further, the Examiner adds Itoh and the admitted prior art with respect to claims 20-21, 23, 25, and 26, adds Ishibashi to Ha, Itoh, and the admitted prior art with respect to claim 24, adds Comer to Ha and Itoh with respect to claims 34-37, 39, and 40, and adds Ishibashi to Ha, Itoh, and Comer with respect to claim 38.

With respect to appealed claims 27-29, 32, 75-77, 79, and 80, the Examiner contends that Ha discloses all of the claimed limitations so as to

¹ In addition, the Examiner relies on Appellants' admissions as to the prior art at pars. [0003] and [0007] of the Specification.

establish a prima facie case of anticipation. In particular, the Examiner contends that Ha discloses the selective downloading of a requested firmware upgrade from a management system to a communication device “without an administrator based on the device ID” as claimed. With respect to the remainder of the appealed claims, the Examiner asserts that the teachings of Ha alone or in various combinations with the cited secondary references establishes a prima facie case of obviousness.

We affirm.

ISSUES

- (1) Under 35 U.S.C § 102(e), with respect to appealed claims 27-29, 32, 75-77, 79, and 80, does Ha have a disclosure which anticipates the claimed invention? Specifically, does Ha disclose the selective downloading of a requested firmware upgrade from a management system to a communication device without administrator involvement?
- (2) Under 35 U.S.C § 103(a), with respect to appealed claims 1-26, 30, 31, 33-40, 69-74, 78, and 81, has the Examiner established a prima facie case of obviousness based on Ha, taken alone, or in various combinations with the secondary references?

FINDINGS OF FACT

Appellants have invented a method and apparatus for selectively downloading from a management device firmware needed by a communication device. The communication device ID is sent to the management device which selects the appropriate firmware for the particular

communication device model and downloads it to the communication device. (Specification 3). According to Appellants (Specification 9), the firmware selection and downloading by a management device eliminates the “time consuming and error prone matching of the appropriate firmware to the communications device by an administrator.”

Ha discloses a method and apparatus for upgrading the basic input-output system (BIOS) software of a personal computer by downloading the appropriate upgrade BIOS software from a host computer. After a determination is made that a request for an upgrade has been made by a personal computer, the personal computer model ID is sent to the host computer (col. 4, ll. 45-53). The appropriate software for the particular personal computer model is read from the storage device of the host computer and transferred to the requesting personal computer (col. 4, ll. 54-61).

Itoh discloses (col. 18, ll. 36-42) the upgrading of BIOS software in which software version information is included in the model identification.

Ishibashi discloses (col. 6, ll. 17-35) the storage of device ID information on non-volatile machine usable storage media in the form of a BIOS-ROM.

Treu discloses (col. 6, ll. 51-55) a communication device in the form of a personal computer which includes ID information which uniquely identifies the communication device.

Comer discloses (page 156) the advantages to the user of using Asymmetric Digital Subscriber Line (ADSL) technology in communication devices permitting a user to send and receive digital information at high speed.

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.

1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thus, the Examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner's conclusion

ANALYSIS

35 U.S.C. § 102(e) REJECTION

With respect to the Examiner's 35 U.S.C. § 102(e) rejection of independent claim 27 based on the Ha reference, Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Ha so as to establish a case of anticipation.² Initially, Appellants contend (Br. 9-10) that Ha lacks a disclosure of the initiation of a firmware upgrade based on a device ID without administrator involvement as claimed.

We agree with the Examiner (Answer 34-35), however, that there is simply no administrator involvement in Ha's software upgrade procedure.

² Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)].

As indicated, for example, at column 4, lines 45-67 of Ha, the host computer acts on a request by a personal computer for a BIOS software upgrade by selecting and downloading the appropriate software upon receipt of the personal computer model ID information.

We also find to be unpersuasive, and not commensurate with the scope of claim 27, Appellants' related argument (Reply Br. 1-2) which emphasizes that, in Ha, the host computer does not initiate the upgrade procedure but, rather, acts on a request from the personal computer for an upgrade. It is our opinion that Appellants' arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

We find no language in appealed claim 27 which requires that the management device start the upgrade procedure or, conversely, precludes the communication device from initiating the upgrade procedure. It is also our view that, although the host computer in Ha waits for an upgrade request from the personal computer, Ha's software upgrade disclosure can be reasonably interpreted as describing the initiation of the upgrade at the host computer since the upgrade procedure cannot start or be "initiated" until the host computer receives the model ID information from the personal computer.

In view of the above discussion, we find that Appellants have not successfully rebutted the Examiner's prima facie case of anticipation with respect to independent claim 27, as well as claims 28, 29, 32, 75-77, 79, and 80 not separately argued by Appellants.

35 U.S.C § 103(a) REJECTION

With respect to the Examiner's obviousness rejection of independent claim 1 based on the combination of Ha and Itoh, Appellants' arguments in response assert a failure to set forth a prima facie case of obviousness since all of the claim limitations are not taught or suggested by the Ha and Itoh references. In particular, Appellants contend (Br. 13-14) that Itoh does not cure the deficiency of Ha in disclosing the initiation of a firmware upgrade without administrator invention. Aside from the fact that our earlier discussion found that Ha, in fact, does disclose software updating without administrator intervention, we find Appellants' contention to be without merit since the Examiner has relied upon Ha, not Itoh, for a teaching of downloading software from a management device to a communication device without administrator intervention. It is apparent from the Examiner's line of reasoning in the Answer that the basis for the obviousness rejection is the combination of Ha and Itoh. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881(CCPA 1981); *In re Merck & Co., Inc.*, 800 F. 2d 1091, 1096, 231 USPQ 375, 380 (Fed. Cir. 1986).

We further find, Appellants argument (Reply Br. 3) to the contrary notwithstanding, no error in the Examiner's establishment (Answer 11, 37) of proper motivation for the combination of Itoh with Ha. In our view, the ordinarily skilled artisan would have recognized and appreciated that Itoh's teaching of including a software version number, i.e., revision number, as part of the computer model identification for software upgrade purposes would serve as an obvious enhancement to the system of Ha.

In view of the above discussion, we find no error in the Examiner's establishment of a prima facie case of obviousness, based on the combination of Ha and Itoh, with respect to appealed claim 1, as well as claims 2-5, 7, 10, 12, 13, 15-19, 30, 69, 73, and 81 not separately argued by Appellants.

Appellants' arguments (Br. 17-22) with respect to the Examiner's obviousness rejection of the remaining appealed claims 6, 8, 9, 11, 14, 20-26, 31, 33-40, 74, and 78 based on Ha in various combinations with the secondary references similarly rely on the assertion that the secondary references do not cure the deficiency of Ha in disclosing the initiation of software upgrade without administrator intervention. We similarly find this argument to be unpersuasive since we found, as discussed earlier, that Ha

does, in fact, disclose the initiating of software upgrade downloading without administrator intervention.

CONCLUSION OF LAW

With respect to independent claim 27, as well as claims 28, 29, 32, 75-77, 79, and 80 not separately argued by Appellants, the Examiner has established a prima facie case of anticipation based on the teachings of Ha which has not been overcome by any convincing arguments from Appellants. A prima facie case of obviousness which has not been successfully rebutted by Appellants has also been established by the Examiner with respect to appealed claims 1-26, 30, 31, 33-40, 69-74, 78, and 81 based on various combinations of Ha with the secondary references.

DECISION

In view of the foregoing, we affirm the Examiner's 35 U.S.C § 102(e) rejection of appealed claims 27-29, 32, 75-77, 79, and 80 as well as the 35 U.S.C § 103(a) rejection of appealed claims 1-26, 30, 31, 33-40, 69-74, 78, and 81.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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